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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,726	09/02/1999	DR. HOWARD AN	OSTEONICS3.0	4364
530 7590 11/28/2003 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			EXAMINER PELLEGRINO, BRIAN E	
			ART UNIT 3738	PAPER NUMBER 27
DATE MAILED: 11/28/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/388,726

Applicant(s)

AN ET AL.

Examiner

Brian E Pellegrino

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-7,9-15,18-33 and 41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14,19 and 21-24 is/are allowed.
- 6) ☒ Claim(s) 2-7,9-13,15,18,20,25-27 and 41 is/are rejected.
- 7) ☒ Claim(s) 28-33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) ✓
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 26.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/4/03 has been entered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 25 is rejected under 35 U.S.C. 102(b) as being anticipated by Rabbe et al. (WO 96/17564). Fig. 3 shows a corpectomy device having an inner tubular member **21** that is slidably and telescopingly received in an outer member **22**. The examiner is interpreting the claimed element (locking clip) in this way: the apparatus **55** is a locking clip since plate **57** is moveable in clamp **59** and engageable with the first and second members with screw **73** engaging the

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threaded hole **29** of the inner member to lock it in position. Claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974). It can also be interpreted that the apertures at the two ends of the plate **57** have inner surfaces that do not engage the second or inner tubular member. It can also be seen the outer tubular **22** member has a different cross-sectional shape for its outer surface than its inner circular cross-section with the outer being oblong and inner being circular.

Claim 27 is rejected under 35 U.S.C. 102(b) as being anticipated by Erickson (5482417). The recitation "a corpectomy device" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or *the intended use of a structure*, and where the body of the claim does not depend on the preamble for completeness but, *instead*, the process steps or *structural limitations are able to stand alone*. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Fig. 1 shows an inner member with a polygonal shape with corners **84**. It can also be seen there is an outer member **56** having a polygonal passage **58** so that inner member is telescopingly received in the outer member. There is also a movable locking clip **14** defining an aperture **24** with corners. Erickson discloses there are mating surfaces between the locking clip and inner member for engagement, col. 6, lines 27,28.

Claims 5,11,41 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoenhoffer (DE 19622827). Fig. 4 illustrates a corpectomy device with first

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and second members (1,2) and a locking clip 3 rotatably mounted on the first member. Fig. 2 shows the locking clip when locked, engaging the second member. Schoenhoffer also discloses the first member being hollow and having elongated perforations 7 and circular perforations 6 on the second member. Regarding claim 20, it can be said that the locking clip engages the threads of one member and engages the other member by contact.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,4,6,7,9,10,12,15,18,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenhoffer (DE 19622827). Schoenhoffer discloses the claimed invention except for the first and second members in an axial relationship with the second member as the inner member. It would have been obvious to one having ordinary skill in the art at the time the invention was made to reverse the parts and have the second member as the inner member, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. It can be seen that there are threads 4 for engagement with the clip 3, see col. 3, lines 23-26 of

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US 6015436 for English version. It can also be seen the clip includes a first bore 13 for a screw to lock the position of the clip.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenhoffer in view of Barbera et al. (EP 567424). Schoenhoffer is explained supra. However, Schoenhoffer does not disclose both the inner and outer member with outwardly extending flanges. Barbera et al. teach (Fig. 2) a vertebral prosthesis with both the upper and lower parts of the prosthesis having flanges (5,6). It would have been obvious to one of ordinary skill in the art to use a flange at both ends of the prosthesis as taught by Barbera in the device of Schoenhoffer such that more structural support is applied to opposing vertebrae.

Claims 2,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schoenhoffer in view of Matsumoto (4880343). Schoenhoffer is explained supra. However, Schoenhoffer does not disclose the locking clip with inner surface portions of different radii of curvature. Matsumoto teaches (Fig. 3A) a locking clip with inner surfaces having different radii of curvature. It would have been obvious to one of ordinary skill in the art to use an alternative locking clip as taught by Matsumoto with the vertebrae device of Schoenhoffer such that it can move in and out of rotation to engage the threads and more easily lock the implant.

***Allowable Subject Matter***

Claims 14,19,21-24 are allowed.

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Claims 28-33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Pellegrino whose telephone number is (703) 306-5899. The examiner can normally be reached on Monday-Thursday from 8am to 5:30pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached at (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Brian Pellegrino

TC 3700, AU 3738

A handwritten signature in cursive script that reads "Brian Pellegrino". The signature is written in dark ink and is positioned below the typed name and title.